REMARKS

Favorable reconsideration, reexamination, and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks.

Allowable Subject Matter

Applicant gratefully acknowledges the indication, at pages 1 and 4 the Office Action, that Claims 1, 4-6, and 19 are allowed, and that the subject matters of Claim 9-18, 20, and 23-26 are free of the prior art. Applicant notes with dismay that the allowance of Claims 7, 8, 21, and 22 has been withdrawn.

Objection to the Claims

At page 2 of the Office Action, Claims 7-18 were objected to because they allegedly include informalities. More specifically, Claim 7 was objected to because of the recitation of a "threaded insert" and a "first threaded insert". By way of the foregoing amendment to Claim 7, Applicant has adopted Mr. Cozart's kind suggestion and has added the word "first" to Claim 7. Accordingly, Applicant respectfully submits that 7-18 are not objectionable, and therefore respectfully requests withdrawal of the objections thereto.

Rejections under 35 U.S.C. § 102

In the Office Action, beginning at page 3, Claims 7 and 21 were rejected under 35 U.S.C. § 102(b), as reciting subject matters that allegedly are anticipated by U.S. Patent No. 5,212,865, issued to Davis *et al.* ("Davis"). Additionally, Claims 7, 8, 21, and 22 were rejected under 35 U.S.C. § 102(e), as reciting subject matters that allegedly are anticipated by U.S. Patent No. 6,860,173, issued to Newton *et al.* ("Newton"). Applicant respectfully requests reconsideration of these rejections.

Claim 7 relates to an installation tool for installing spiral threaded inserts, comprising a single shaft having a first end including first means for anti-rotation retention and guidance of a first threaded insert, and second means for securing the first threaded insert in the first means.

Claim 21 relates to a method of installing spiral threaded inserts having a combination of steps including, *inter alia*, inserting a first threaded insert into an installation tool, securing the first threaded insert with separate securing means in the installation tool to prevent the insert from falling out, and screwing the first threaded insert into a tapped hole with the installation tool.

The prior art, including *Davis* and *Newton*, fails to identically disclose or describe devices or methods as recited in the combinations of the pending claims.

Davis

Davis discloses an installation tool 10 having two major portions, namely a tubular body member 12, and a mandrel assembly 14 insertable into the tubular body and adapted to receive a tanged or tangless insert (see col. 2, lines 34-38). The mandrel assembly 14 has a longitudinal cutout 32 which receives a pivotable catch or pawl 30 (see col. 3, lines 6-15). The pawl 30 automatically engages an appropriate cutout 52 of a tangless insert 11, thereby providing an anti-rotation retention of the insert with respect to the mandrel assembly 14. When the insert is screwed into a coil alignment portion 19 at the end of the tubular body member 12, while this may be considered operate as a securing means, any such anti-rotation retention means is part of the mandrel assembly 14, while any securing means in *Davis*' device is part of the tubular member 12.

According to the combination recited in Claim 7, however, there is only one shaft having a first end including both the first or anti-rotation retention means and the second or securing means, *i.e.*, the means are not attached to different members of the tool. Accordingly, Claim 7 is not anticipated by *Davis*.

Regarding Claim 21, *Davis* describes forcing the insert 13 to wind itself in the threads of the prewinder or coil-sizing portion 18, which reduces the coil thread diameter for smooth transition into the tapped hole (see col. 2, lines 44-47, and col. 4, lines 5-9). Thus, the coil alignment portion 19 with the prewinder 18 is operated as not a separate securing means, but is mainly used to align and compress the insert prior to be applied. According to the combination

recited in Claim 21, a separate securing means is used during installing the insert and, therefore, Claim 21 is not anticipated by *Davis*.

Newton

Newton issued on 1 March 2005, based on application number 10/318,914, filed on 13 December 2002 (" '914 application"). Because there are no claims for domestic priority made by *Newton* under 35 U.S.C. §§ 119, 120, the actually filing date of the '914 application is the earliest effective filing date of *Newton* and is its 102(e)(2) date.

This application was filed on 11 February 2004, and claims Paris Convention priority under 35 U.S.C. § 119 to German application number 103 05 898.2, filed 13 February 2003.

Applicant conceived of the subject matters of Claims 7, 8, 21, and 22 prior to 13 December 2002, and was diligent until a patent application was filed supporting the subject matters of these claims. Applicant files concurrently herewith a Declaration of Graham Young under 37 C.F.R. §1.131 and a Declaration of Eduard Bruehwiler under 37 C.F.R. §1.131 in which the two inventors herein attest and declare to facts which remove *Newton* as a reference against this application.

More specifically, both the Young Declaration and the Bruehwiler Declaration establish, with their supporting Exhibits, that before 13 December 2002 the inventors herein prepared an Invention Disclosure document and submitted it to their employer, ALSTOM. The details in that Invention Disclosure fully support all of the limitations recited in the combinations of Claims 7, 8, 21, and 22, as detailed in the Declarations. Additionally, the Declarations and their supporting Exhibits detail the diligence practiced between their conception of the claimed combinations and the ultimate filing of a patent application in Germany; priority to that patent application is claimed under 35 U.S.C. § 119 in this application. Indeed, the German priority application was filed only a scant two months after the effective filing date of *Newton*, during which time the German patent application was drafted, revised, finalized, and filed.

Based on the Young Declaration and the Bruehwiler Declaration, and their supporting Exhibits, Applicant has established that the invention recited in Claims 7, 8, 21, and 22 was

conceived of prior to the effective filing date of *Newton*, and that Applicant was diligent to the filing of a patent application disclosing subject matter supporting these claims. Accordingly, Applicant respectfully submits that *Newton* is not prior art against this application under 37 C.F.R. § 1.131, and respectfully requests withdrawal of the rejections of the claims thereover.

Conclusion

For at least the foregoing reasons, Applicant respectfully submits that the subject matter of Claims 7 and 21 are not anticipated by *Davis*, and that *Newton* is not prior art against this application, the claims are therefore not unpatentable under 35 U.S.C. § 102, and therefore respectfully requests withdrawal of the rejection thereof under 35 U.S.C. § 102.

Conclusion

Applicant respectfully submits that the present patent application is in condition for allowance. An early indication of the allowability of this patent application is therefore respectfully solicited.

If Mr. Cozart believes that a telephone conference with the undersigned would expedite passage of this patent application to issue, he is invited to call on the number below.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees necessitated by this paper, and to credit all refunds and overpayments, to our Deposit Account 50-2821.

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